

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TOSHIKAZU KAJI

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Appeal No. 97-2287  
Application No. 08/299,128<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, JERRY SMITH, and BARRY, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 7 and 8. In an Amendment After Final (paper number 7), claims 3 and 8 were amended. After submission of the

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<sup>1</sup> Application for patent filed September 2, 1994.

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amendment, the examiner withdrew the indefiniteness rejection of claims 7 and 8, and the obviousness rejection of claim 2 (paper number 8). Accordingly, claim 1 remains before us on appeal.

In the disclosed film conveying apparatus, an edge of a guide plate is urged against an edge of the film. The edge of the guide plate has a larger width than the width of concave portions formed in the edge of the film.

Claim 1 reads as follows:

1. An information processing apparatus which conveys a film, in which a recording portion is provided, comprising:

information transfer means for transferring said information in at least one of a reading and recording mode;

a guide plate on which said information transfer means is mounted, said guide plate being capable of moving close to or away from a side edge of the film and having one edge following surface which abuts said side edge of the film; and

urging means for urging the edge following surface of said guide plate against said side edge of the film and for causing said guide plate to follow the film if the film is fishtailing,

a dimension of said edge following surface in a direction in which the film is conveyed being larger than a dimension of the width of openings of concave portions formed in said side edge of the film.

The reference relied on by the examiner is:

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Bloemendaal et al. (Bloemendaal) 5,400,200 Mar. 21,  
1995  
(filed Sept. 14, 1992)

Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Bloemendaal or, in the alternative, under 35 U.S.C. § 103 as being obvious over Bloemendaal.

Reference is made to the brief, the amended reply brief (paper number 16) and the answer for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the rejections of claim 1.

In the statement of the rejection under 35 U.S.C. § 102(e), the examiner explains (Answer, page 4) that:

While Bloemendaal does not explicitly disclose "concave portions" formed along a film edge (10), said portions are deemed inherent since photographic films typically have such concave portions. And assuming that these portions are inherent, the size of said portions, i.e., the "dimension of the width of openings of concave portions," is inherently deemed smaller than the width of said edge following surface . . . .

In the statement of the rejection under 35 U.S.C. § 103, the examiner explains (Answer, page 5) that:

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Assuming *arguendo* that the concave portions are not inherent in Bloemendaal, then it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bloemendaal by substituting its film with a film containing concave portions because this is deemed a mere substitution of art recognized equivalents, and hence, an alternative embodiment without producing new and unexpected results is obtained . . . .

Furthermore, assuming *arguendo* that the now modified system does not contain concave portions which are smaller than the recited dimension of the edge following surface, it would have been obvious to increase the size - the length - of the edge following surface to improve the tracking ability of the head (16) upon playback of the recorded signal (14) . . . .

Appellant argues (Amended Reply Brief, pages 2 and 3)

that:

For the inherency doctrine to be applicable to the instant rejection, it must be the case that the Bloemendaal et al. reference is only directed to the type of film with concave portions along the edge. Bloemendaal et al. does not disclose film with concave portions, and the Examiner admits this. (Paper No. 6, page 5, lines 6-7). However, the one type of film that Bloemendaal et al. does show is straight-edged, i.e., has no concave portions. Thus, inherency cannot legally be used to import non-disclosed film having concave portions.

Furthermore, assuming *arguendo* that films with concave portions were disclosed in the Bloemendaal et al. reference, inherency cannot legally be used to allege that the edge follower must be longer than concave portions, since there is no showing of

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record that the edge follower could only be longer than concave portions.

Appellant summarizes his position by stating (Brief, pages 4 and 5) that:

Appellant respectfully submits that the Examiner has failed to set forth a *prima facie* case of obviousness or anticipation . . . . The Examiner's conclusion that the film edge followers 28 and 30 are larger than the width of concave portions which are not even shown or suggested in the reference is a "leap of faith" which is wholly unsupported by any cited reference, and does not meet the standards required by § 102 and § 103 to constitute a *prima facie* case of unpatentability.

Inasmuch as we agree with appellant's argument's, we will reverse the 35 U.S.C. § 102(e) and the 35 U.S.C. § 103 rejections of claim 1.

#### DECISION

The decision of the examiner rejecting claim 1 under 35 U.S.C. § 102(e) and 35 U.S.C. § 103 is reversed.

#### REVERSED

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KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
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	)	
	)	BOARD OF PATENT
JERRY SMITH	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	

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APJ HAIRSTON

APJ BARRY

APJ JERRY SMITH

DECISION: REVERSED  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s): \_\_\_\_\_

Prepared: May 22, 2000

Draft      Final

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PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT